

Supreme Court, U. S.

FILED

MAR 3 1976

MICHAEL RODAK, JR., CLERK

In the
Supreme Court of the United States

OCTOBER TERM, 1975

No. **75-1244**

WILBUR T. BOLKCOM and WILLIAM E. KNAPP,
Petitioners,

v.

THE CARBORUNDUM COMPANY,
Respondent.

PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT

ARLAND T. STEIN
THOMAS C. WETTACH
REED SMITH SHAW & McCLAY
747 Union Trust Building
Pittsburgh, Pennsylvania 15230
Attorneys for Petitioners

Financial Press Corporation, Pittsburgh

187 USPQ 466

TABLE OF CONTENTS

	<u>Page</u>
OPINIONS BELOW	1
JURISDICTION	2
QUESTIONS PRESENTED	2
STATEMENT OF THE CASE	2
REASONS FOR GRANTING REVIEW	8
I. There Is A Conflict Among The Courts Of Appeals On The Statutory Authority Of The Commissioner of Patents To Grant Reissue Patents With Claims Enlarging Or Narrowing The Scope Of The Claims Of The Original Patent.	8
II. It Is Time To Renew And Vitalize The Doctrine of Equivalents With Its Importance To The Application Of The Patent Laws. The Court Of Appeals Decision Abrogates The Doctrine Of Equivalents Established By This Court To Guarantee To Patentees The Statutory Right Of Exclusivity.	16
CONCLUSION	22

TABLE OF CITATIONS

CASES

	<u>Page</u>
<i>Crane Packing Co. v. Spitfire Tool & Machine Co.</i> 275 F.2d 271 (7 Cir., 1960), cert. den. 363 U.S. 820	14
<i>Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co.</i> , 339 U.S. 605 (1950)	2, 16, 17, 18, 19, 20, 22
<i>Handel, Application of</i> , 312 F.2d 943 (CCPA, 1963)	15
<i>Hartzell Industries, Inc. v. McCauley Industries Corp.</i> , 304 F.2d 481 (6 Cir., 1962)	9
<i>Hazeltine Research Inc. v. Avco Mfg. Corp.</i> , 227 F.2d 137 (7 Cir., 1955), cert. den. 350 U.S. 987	14
<i>Hickory Springs Mfg. Co. v. Fredman Brothers Furniture Co. Inc. et al</i> , 509 F.2d 55 (1975)	13
<i>Kearney & Trecker Corp. v. Tiddings & Lewis, Inc.</i> 452 F.2d 579 (7 Cir., 1971) cert. den. 405 U.S. 1066	14
<i>Lockwood v. Langendorf United Bakeries, Inc.</i> 324 F.2d 82 (9 Cir., 1963)	13
<i>Marconi Wireless Telegraph Co. v. United States</i> 81 Ct. Cl. 671 (Ct. Cl., 1935), aff'd in part and rev'd in part, 320 U.S. 1 (1943)	21, 22
<i>Maxant Button & Supply Co. v. Sears, Roebuck & Co.</i> , 388 F.2d 912, (7 Cir., 1968)	14
<i>McCullough Tool Co. v. Well Surveys, Inc.</i> 343 F.2d 381 (10 Cir., 1965) cert. den. 383 U.S. 933	13, 21
<i>Parker and Whipple Co. v. Yale Lock Co.</i> 213 U.S. 87 (1887)	11, 12, 14
<i>Riley v. Broadway-Hale Stores Inc.</i> 217 F.2d 530 (9 Cir., 1954)	13

Page

<i>Sanitary Refrigerator Co. v. Winters</i> 280 U.S. 80 (1929)	17
<i>Scovill Mfg. Co. v. Goldblatt Brothers, Inc. et al</i> 362 F.2d 777, (7 Cir., 1966) cert. den. 385 U.S. 970	14
<i>Sears, Roebuck & Co. v. Minnesota Mining & Mfg. Co.</i> 243 F.2d 136 (4 Cir., 1957) cert. den. 355 U.S. 932	13
<i>Tektronix, Inc. v. United States</i> 445 F.2d 323 (Ct. Cl., 1970)	21, 22
<i>Tigrett Industries v. Standard Industries</i> 397 U.S. 586, (1970) reh. den. 398 U.S. 944	17
<i>U. S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.</i> , 315 U.S. 668 (1942)	8, 9, 11, 12, 13, 14
<i>Union Asbestos & Rubber Co. v. Paltier Corp.</i> 298 F.2d 48-51-54 (7 Cir., 1962) cert. den. U.S. 865	14
<i>Weller Mfg. Co. v. Wen Products, Inc.</i> 231 F.2d 795 (7 Cir., 1956)	14
<i>Wesseler, Application of</i> , 367 F.2d 838 (CCPA, 1966) ..	15
<i>Winans v. Denmead</i> , 56 U.S. 545 (15 How. 330) (1853)	17
<i>Ziegler v. Phillips Petroleum Co.</i> , 483 F.2d 858 (5th Cir., 1973) cert. den. 414 U.S. 1079	20

STATUTES

28 U.S.C. §1254	2
35 U.S.C. §64 (repealed)	2, 9, 10, 11, 12, 16
35 U.S.C. §112	5, 16
35 U.S.C. §251	2, 7, 8, 9, 10, 11, 12, 13, 14, 15

MISCELLANEOUS

<i>Patent Law Perspectives</i> , Annual Reviews B.1 [1] [b], Dunner, Gambell, and Kayton	17, 21
--	--------

In the
Supreme Court of the United States

OCTOBER TERM 1975

No.

WILBUR T. BOLKCOM and WILLIAM E. KNAPP,
Petitioners,

v.

THE CARBORUNDUM COMPANY,
Respondent.

**PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT**

Petitioners, Wilbur T. Bolkcom and William E. Knapp, ask that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Sixth Circuit in this case entered on September 30, 1975.

OPINIONS BELOW

The opinion of the court of appeals was entered September 30, 1975, on a hearing held October 5, 1973. The opinion and judgment are reported at 523 F.2d 492 and appended hereto as Appendix A, pp. 1a-12a. The opinion of the district court was rendered orally at the end of the trial. The opinion and judgment of the district court are unreported and are appended thereto as Appendix B, pp. 14a-29a, 51a. The findings and conclusions of the district

court consistent with the opinion are also part of Appendix B, pp. 30a-50a.

JURISDICTION

The judgment of the court of appeals was entered on September 30, 1975 (Appendix A, p. 12a). A timely petition for rehearing was denied on December 4, 1975 (Appendix A, p. 13a). The jurisdiction of this Court is invoked under 28 U.S.C. §1254 (1).

QUESTIONS PRESENTED

1. Whether the statute governing reissue of patents, §251 of the 1952 Patent Act, can be interpreted to void claims of reissue patents enlarging or narrowing the scope of the claims of the original patent, contrary to the express terms of that statute, by engrafting thereon additional legal criteria created by repealed statute §64, R.S. §4916 (1928).

2. Whether the doctrine of equivalents last enounced in *Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co.*, 339 U.S. 605 (1950) can be abrogated by finding incidental differences between one element of a patented combination and a corresponding element of an accused combination where the accused combination is found virtually identical with the patented combination in every other respect and the particular element is found to perform substantially the same function to achieve the same result as the element of the patented combination.

STATEMENT OF THE CASE

Background:

Petitioners, Bolkcom and Knapp, are the coinventors-patentees of United States Patent No. Re. 27,018 (hereinafter Patent '018), granted January 5, 1971, and United States Patent No. 3,423,605 (hereinafter Patent '605), granted

March 11, 1969. Patent '018 is the patent in suit and a reissue of Patent '605. A copy of Patent '018 is appended hereto as Appendix C, pp. 52a-59a.

The invention claimed in the patents is a novel plant for the manufacture of silicon carbide. Silicon carbide was first made in 1891 by Edward Acheson, the founder of respondent Carborundum. It is made by fusing a mixture of silica sand (SiO_2) and carbon (C), such as coke or graphite, in a furnace heated by an electrical resistance core to an extremely high temperature (about 4,000° F) for about 30 hours.

From its discovery in 1891 until the advent of petitioners' invention in 1966, seventy-five years later, all silicon carbide manufactured in North America was made in fixed, immovable furnaces. These stationary furnaces were set in banks of four (4) to six (6), close to one another and to the electrical power source used for firing. The furnaces in a bank were typically operated in a cycle, with one furnace being loaded, one furnace being fired, at least one furnace cooling and one furnace being unloaded. The total cycle took about five to seven days for each furnace. Each stationary furnace requires approximately three days to cool after firing, before the workmen could unload it and load a new charge. Hand labor was used in loading and unloading the furnaces, and the cramped working conditions and high temperatures resulting from the close proximity of the furnaces to each other and to the electrical source made this activity extremely difficult and dangerous.

The Invention:

The patented invention is built on the concept of using mobile furnaces, mounted on wheels, that could be removed from the electric power source after firing, placed at a distance for cooling and stripping (without totally cooling as with the stationary furnaces), moved to another area of the

plant for reloading, and again moved to the electrical source for firing. The invention has the ability of selectively moving each furnace car through the entire cycle—firing, cooling, stripping and reloading— without interfering in any way with the operating cycle of any other mobile furnace.

The selectivity is achieved by a "transfer car" (or "transfer means") having a trackway on top, which may be aligned with any trackway in the furnace area, cooling/stripping area or loading area of the plant. The furnace car is selectively moved from one area to another by aligning the trackways on the transfer car with the trackways supporting the furnace car, moving the furnace car onto the transfer car, moving the transfer car with the furnace car on it into alignment with trackways of another area, and moving the furnace car off the transfer car onto the trackways of the other area.

The combination invention is described in a detailed summary in both the original and reissue patents as follows:

"... an electrical power source, a main trackway adjacent said power source, a furnace bottom mounted on wheels on said trackway movable to and away from said power source; said furnace bottom having a substantially flat heat resistant surface, removable sides along each side of said surface and removable ends on said surface, said sides and ends defining a heating chamber, electrode means in each of said ends, removable connections between said electrode ends and said power source, a transfer car movable transversely to the main trackway and having a corresponding trackway adapted to be aligned with the main trackway to receive the furnace bottom wheels and furnace whereby said furnace may be moved transversely to said main trackway, a service area spaced from said main trackway by said transfer car, secondary trackways in said service area receiving said

furnace from said transfer car, loading means at said service area adapted to load said furnace and a cooling and unloading section in said service area spaced from the loading means." [Appendix C, Col. 1, line 61 — Col. 2, line 9.]

Petitioners conceived their invention in 1964, and successfully reduced it to practice in April 1966 at their Springdale, Pennsylvania plant, where they began the commercial production of silicon carbide. After this plant began operations, Petitioners filed an application for Letters Patent that matured into Patent '605.

The Reissue Patent:

Reissue Patent '018 is identical to the original Patent '605 except for the addition of claims 11-14. Not one word, number or line of the description in the specification and drawings was changed. And claims 1-10 of Patent '018 are the same as the claims of Patent '605.

Claims 11-14 enlarged the scope of the claims from the original patent, but only in two substantive respects: First, the requirement that the "transfer car" be movable "on a trackway extending transversely to the main trackway" (claim 1) was removed to make the claim commensurate with the broader description in the specification, above quoted, *supra*, p. 4. Second, the "transfer car" was prescribed as a "transfer means between the first trackway and the second trackway selectively delivering a furnace car from one to the other" to enable the claims to cover the embodiments "described in the specification and equivalents thereof" in accordance with 35 U.S.C. §112.

The reissue of the patent was spawned when, shortly after the original patent was issued, petitioners learned of respondent's plan to build a mobile furnace plant for making silicon carbide at Jacksboro, Tennessee. Bolcom and Knapp counseled with their patent counsel and were advised

that their patent was sufficient to cover the proposed plant, as they were advised it would be. The investigation concluded, however, that the patent claims were not adequate to cover the patented combination where the transfer means were ladder tracks, overhead cranes and turntables not supported on trackways; and the reissue resulted.

The Accused Combination:

Respondent's Jacksboro Plant went into operation in April 1971, shortly after its completion. This marked Carborundum's first departure from the stationary manufacturing plant proposed by Acheson in 1891, despite a continuing search by its skilled personnel for a more facile, economical and efficient way of making silicon carbide.

The Jacksboro Plant came about after respondent became fully advised of petitioners' invention. Bolkcom and Knapp sought to interest Carborundum in licensing or buying their invention. To that end, two of Carborundum's officials visited the Springdale Plant on May 12, 1967, and were given a copy of the original patent application, then pending.

July 5, 1968 is the date of the sketch layout of Carborundum's proposed mobile furnace plant at Jacksboro. It reveals that Carborundum proposed to use petitioner's combination verbatim with the transfer means that its representatives had seen at the Springdale Plant, namely, a transfer car movable linearly on supporting tracks extending transversely of the trackways for the mobile furnaces.

The plant combination actually built at Jacksboro was virtually identical in every respect to the Springdale Plant except that a turntable supported at its periphery on curved trackways extending transversely of the trackways for the mobile furnace was used instead of a transfer car movable

linearly on supporting transverse tracks. The purported reason for the change was that "to utilize a surplus railroad turntable in place of the transfer car previously planned . . . could save us about \$90,000."

Decisions Below:

The district court held that claims 1-10 of Patent '018 (identical to the claims of Patent '605) were valid, but were not literally infringed by the accused combination, even though that combination was virtually identical in all other respects except that it employed a turntable instead of a linear transfer car to achieve selectivity. The district court also found that a turntable was not equivalent to the linear transfer car arrangement. The district court did find that the accused combination with the turntable responded to the broader reissue claims 11-14 with the "transfer means," but found those claims were invalid under 35 U.S. C. §251 as an "unauthorized enlargement of the disclosure of the patent."

The court of appeals affirmed the decision of the district court finding claims 1-10 of Patent '018 valid, 523 F.2d at 498-501. The circuit court again found that the accused plant was "virtually identical with" the patented combination of claims 1-10 "in every other respect [except it] utilized a turntable instead of a transfer car to transport the mobile furnaces," 523 F.2d at 502, and found that "the turntable does perform substantially the same function as the transfer car" to achieve "the same result," 523 F.2d at 502,503. But the court declined to overturn the district court's finding of non-equivalence.

The court of appeals found that the accused combination with a "turntable apparently falls within the broader reissue claims coverage of a 'transfer means'," 523 F.2d at 498. And, on validity of claims 11-14, the circuit court found, 523 F.2d at 497:

"Typical of the new claims added, 11-14, is claim 11, which is *identical* to claim number 1 *in substance except*

that it provides for achieving the desired selectivity through the use of a 'transfer means' instead of a 'transfer car on a track transverse to the main trackway'." [Emphasis added.]

Yet, the court found claims 11-14 "were an unauthorized enlargement of the disclosure in the original patent" following *U. S. Industrial Chemicals, Inc. v. Carbide & Carbon Corp.*, 315 U.S. 668 (1942), and affirmed the finding of invalidity of them.

REASONS FOR GRANTING REVIEW

I. THERE IS A CONFLICT AMONG THE COURTS OF APPEALS ON THE STATUTORY AUTHORITY OF THE COMMISSIONER OF PATENTS TO GRANT REISSUE PATENTS WITH CLAIMS ENLARGING OR NARROWING THE SCOPE OF THE CLAIMS OF THE ORIGINAL PATENTS.

This case presents issues of first impression for this Court of substantial general importance with respect to the interpretation of the reissue section of the 1952 Patent Act. This Court has never considered §251, U.S.C. Title 35, governing the reissue of patents. The question in this case is crucial to the validity of hundreds of reissue patents with claims enlarging or narrowing the scope of the original patents.

To date, five courts of appeals and the Court of Customs and Patent Appeals have adopted conflicting standards on the propriety of reissuing patents with broadened or limited claims under §251, U.S.C. Title 35. The Seventh Circuit and the Court of Customs and Patent Appeals have followed the express language of §251 and

validated reissue patents "for the invention disclosed in the original patent . . . enlarging [and narrowing] the scope of the claims," provided "no new matter" was introduced in the application for reissue. The Fourth Circuit, Ninth Circuit, Tenth Circuit and now the Sixth Circuit¹ have adopted more restrictive standards on reissue of patents. The latter decisions purport to follow *U. S. Industrial Chemical, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U. S. 668 (1942), construing repealed statute §64, R.S. §4916, May 24, 1928, which requires that the reissue patents be "for the same invention" as the original patent. The conflict involves important issues which have not, but should be decided by this Court.

Section 251 of the 1952 Patent Act provides for "Reissue of Defective Patents" as follows:

"Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, *reissue the patent for the invention disclosed in the original patent*, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. *No new matter* shall be introduced into the application for reissue.

The Commissioner may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

¹ The Sixth Circuit appeared to construe §251 in accordance with its express language, *Hartzell Industries, Inc. v. McCauley Industrial Corp.*, 304 F.2d 481 (1962), but adopted a different, restrictive interpretation in this case without reference to its earlier decision.

The provisions of this title relating to applications for patents shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted *enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.* July 19, 1952, c. 950, §1, 66 Stat. 808." [Emphasis added.]

This statute provides that reissue patents can enlarge (within two years) or narrow the scope of the claims of the original patent where the patentee claimed "more or less than he had a right to claim" in the original patent.

Prior to the enactment of 35 U.S.C. §251, a patentee was entitled to a reissue patent under the provisions of §64,² R.S.

² "Whenever any patent is wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery *more* than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause *a patent for the same invention*, and in accordance with the corrected specification, to be reissued to the patentee or to his assigns or legal representatives, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the reissued patent, but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent to the extent that its claims are identical with the original patent shall constitute a continuation thereof and have effect continuously from the date of the original patent. The commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. The specifications and claims in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so reissued, together with the corrected specifications, shall have the same

(continued)

§4916, May 24, 1928 c. 730, 45 Stat. 732. That section did not by its terms provide that a patentee could enlarge the scope of the claims by obtaining a reissue patent. Rather, §64 provided that the Commissioner of Patents "shall . . . cause a patent *for the same invention*, and in accordance with the corrected specification, to be issued to the patentee . . .".

The "same invention" requirement was last interpreted by this Court in *U. S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. 668, 675-76 (1942). There, the Court held, *inter alia*, that:

"[I]t is not enough that an invention might have been claimed in the original patent because it was suggested or indicated in the specification. It must appear from the face of the instrument that what is covered by the reissue was intended to have been covered and secured by the original."

While this holding was consonant with earlier decisions under prior Patent Acts containing the "same invention" requirement which limited reissue patents enlarging and narrowing claims to strict standards, see, e.g., *Parker and Whipple Co. v. Yale Lock Co.*, 123 U.S. 87 (1887), the decision does not present the standards controlling the reissue of patents under the Patent Act of 1952.

Section 64 of the Revised Statutes was repealed by the Act of July 1952, c. 950, §1.66 Stat. 792, which enacted into law a new reissue statute, §251. Section 251 made three (3)

effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; *but no new matter shall be introduced into the specification*, nor in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid." [Emphasis added.]

important changes from the prior statutory law with its judicial interpretation:

1. It specifically provided that a reissue patent can be granted enlarging the scope of the claims of the original patent if the reissue patent is applied for within two years of grant of the original patent;

2. It provided when the patentee claimed "more or less than he had a right to claim in the [original] patent, the Commission shall . . . reissue the patent for the invention disclosed in the original patent" with "the provisions of this title relating to applications for patent . . . applicable to applications for reissue . . ."; and

3. It eliminated the requirement that the claims of the reissue be "for the same invention" as the original patent.

Notwithstanding the change of law effected by §251, certain circuits have continued to restrict reissue patents by engrafting on the express terms of the statute the legal criteria of repealed statute §64 as judicially interpreted. The Sixth Circuit forcefully states the position of these courts of appeals in the present case. Citing and quoting *U.S. Industrial Chemicals Co. v. Carbide & Carbon Chemicals Corp.*, *supra*, and *Parker and Whipple Co. v. Yale Lock Co.*, *supra*, the Court found, 523 F.2d at 502:

"The Supreme Court has made it clear that *this section* [§251] is intended only to permit the reissue of a new patent for *the same invention* as that disclosed in the original patent in order to permit the correction of an innocent inadvertent defect or omission. *It is not intended to permit the patentee to broaden the claims of the original patent.*" [Emphasis added in part]

Applying this enunciation, the court found that the new claims (i.e., claims 11-14) added by reissue were not limited

in scope to the explicit disclosure of the original patent and "were an unauthorized enlargement of the disclosure in the original patent" 523 F.2d at 502.

The Fourth, Ninth and Tenth Circuits have enounced similar standards governing the reissue of patents. These courts of appeals too do not consider the statutory changes brought by §251. Following *U.S. Industrial Chemicals* and other decisions under repealed section 64, these courts require that a reissue patent, unlike an original patent, must be limited to the same invention "explicitly disclosed and taught" in the original application for patent:

"It must appear upon the face of the original patent that the matter covered by the reissue was intended to have been covered and secured by the original *The broader claims of the reissue must be more than merely suggested or indicated in the original patent.* *U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. 668, 675-676, 62 S.Ct. 839, 844, 86 L.Ed. 1105. As observed in that case, "it is not enough that an invention might have been claimed in the original patent because it was suggested or indicated in the specification." *Riley v. Broadway-Hale Stores Inc.*, 217 F.2d 530, 532. (9 Cir., 1954) [Emphasis added.]

Accord, McCullough Tool Co. v. Well Surveys, Inc. 343 F.2d 381, 389 (10 Cir., 1965) *cert. den.* 383 U.S. 933; *Lockwood v. Langendorf United Bakeries, Inc.*, 324 F.2d 82, 94 (9 Cir., 1963); and *Sears, Roebuck & Co. v. Minnesota Mining & Mfg. Co.* 243 F.2d 136, 140 (4 Cir., 1957) *cert. den.* 355 U.S. 932.

On the other hand, the Seventh Circuit has taken the view that §251 "is remedial in intent and should be read liberally", *Hickory Springs Mfg. Co. v. Fredman Brothers Furniture Co. Inc. et al.*, 509 F.2d 55, 61 (1975). That court of appeals has found that the reissue privilege has been broadened by §251 with the limitation remaining that no

"new matter" shall be added by way of reissue. Literally applying the statutory provision, the Seventh Circuit has consistently held:

"[W]e are of the opinion that an *applicant for reissue may fully describe his original invention and include in his new description and claims* not only what was described before, but also what was suggested or implied in the original drawings, specifications and models. Inasmuch as the justified finding of the court was that *the reissue patent included only the inherent function and mode of operation of the original patent*, it follows that *no new matter* was introduced." *Weller Mfg. Co. v. Wen Products, Inc.* 231 F.2d 795, 800 (7 Cir., 1956) [Emphasis added.]

Accord, Hazeltine Research Inc. v. Avco Mfg. Corp. 227 F.2d 137, 143-44 (7 Cir., 1955) *cert den.* 350 U.S. 987; *Scovill Mfg. Co. v. Goldblatt Brothers, Inc. et al*, 362 F.2d 777, 779-80 (7 Cir., 1966) *cert den.* 385 F.2d 970; *Maxant Button & Supply Co. v. Sears, Roebuck & Co.*, 388 F.2d 912, 916-17 (7 Cir., 1968); and *Kearney & Trecker Corp. v. Tiddings & Lewis, Inc.* 452 F.2d 579, 593 (7 Cir., 1971) *cert den.* 405 U.S. 1066. See also, *Union Asbestos & Rubber Co. v. Paltier Corp.* 298 F.2d 48, 51-54 (7 Cir., 1962) *cert. den.* 369 U.S. 865; and *Crane Packing Co. v. Spitfire Tool & Machine Co.* 276 F.2d 271, 274 (7 Cir., 1960) *cert. den.* 363 U.S. 820.

Similarly, the Court of Customs and Patent Appeals (CCPA) has expressly rejected a restrictive interpretation of §251. Citing *U. S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, *supra*, and *Parker and Whipple Co. v. Yale Lock Co.*, *supra*, the CCPA observed that "these cases were prior to the enactment of the Patent Act of 1952, which changes the words of the prior law, 'for the same invention', to the words above-quoted ['for the invention disclosed in the original patent']", and went on to hold:

"[I]f the board's view were to prevail, the reissue statute would be of very little practical effect, for, by elementary principles of claim interpretation, whenever an element or other limitation is added to or taken from a claim it becomes a claim to a different invention. *Yet the whole purpose of the statute, so far as claims are concerned, is to permit limitations to be added to claims that are too broad or to be taken from claims that are too narrow.* That is what the statute means in referring to 'claiming more or less than he had a right to claim'". *Application of Handel*, 312 F.2d 943, 948 (CCPA, 1963). [Emphasis added.]

Accord, Application of Wesseler, 367 F.2d 838, 847-48 (CCPA, 1966).

The Seventh Circuit and CCPA have, therefore, construed §251 to mean that it is enough that the invention might have been claimed in the original patent. Those courts have found that the patentee has the right to reissue a patent to cover the invention disclosed in the original application as fully as he could have in the original application in accordance with "the provisions of this title relating to applications for patent". Moreover, those courts hold that the patentee is entitled to utilize the remedial provisions of §251 to claim his invention in a reissue of his patent by omitting or adding limitations in the claims provided he can show that claiming "more or less than he had a right to claim" in the original patent was "through error" and added "no new matter".

The present case clearly presents the conflicting positions of the lower courts for decision. Here, the specification, drawings and claims 1-10 of the original and reissue patents are identical. No "new matter" was added. The objection is that the new reissue claims eliminated the requirement that the "transfer car" be movable "on a trackway extending transversely to the main trackway," and

substituted for the "transfer car," a "transfer means . . . selectively delivering a furnace car from one [trackway] to the other [trackway]" in the enlarged claims (claim 11). The former change made the claims of the patent commensurate with the description of the invention in the specification, quoted *supra*, p. 4 (Appendix C, Col. 1, line 61 - Col. 2, line 9); and the latter change enlarged the claim consonant with 35 U.S.C. §112 which ordains that "a means . . . for performing a specified function . . . shall be construed to cover the corresponding structure, material or acts described in the specification and equivalents thereof."

Accordingly, the reissue patent in this case enlarged the scope of the claims to cover the "invention disclosed" that could have properly been claimed in the original patent. The claims are valid by the standards applied by the Seventh Circuit and the CCPA. Yet these claims were held invalid as "an unauthorized enlargement of the disclosure" by engrafting the restrictive legal criteria of repealed §64. The conflict clearly involves a substantial question of general impact which has not, but should be resolved by this Court.

II. IT IS TIME TO RENEW AND VITALIZE THE DOCTRINE OF EQUIVALENTS WITH ITS IMPORTANCE TO THE APPLICATION OF THE PATENT LAWS. THE COURT OF APPEALS DECISION ABROGATES THE DOCTRINE OF EQUIVALENTS ESTABLISHED BY THIS COURT TO GUARANTEE TO PATENTEES THE STATUTORY RIGHT OF EXCLUSIVITY.

This case also presents issues of substantial nationwide importance with respect to the viability of the doctrine of equivalents. The doctrine of equivalents was last enounced twenty-five (25) years ago in *Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co.*, 339 U.S. 605 (1950). Since then,

the courts of appeals have taken diverse positions in applying the doctrine particularly since this Court's decision in *Tigrett Industries v. Standard Industries*, 397 U.S. 586 (1970), *reh. den.* 398 U.S. 944³. The present case is a classic for denominating equivalence, providing an extraordinary opportunity for the Court to rejuvenate and develop the methodology of the doctrine of equivalents: The facts of the case are relatively simple; the lower courts made all the factual findings necessary for a finding of equivalents adjudged by the criteria of *Graver Tank*; and yet, the lower court failed to find equivalence based on an incidental difference between one element of the accused combination and a corresponding element of the patented combination.

The doctrine of equivalents is a principle of equity that originated over 120 years ago in *Winans v. Denmead*, 56 U.S. 545 (15 How. 330) (1853). The doctrine provides that even though the accused device or practice does not literally meet the claims of the patent, it nonetheless infringes "if it performs substantially the same function in substantially the same way to obtain the same result." *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30, 42 (1929). The reasons for the doctrine were forcefully stated by the Court in *Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co.*, *supra* at 607:

"[C]ourts have . . . recognized that to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing. *Such a limitation would leave room for — indeed encourage — the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent*

³ *Tigrett Industries* cast doubt on this Court's continued acceptance of the doctrine of equivalents because of the amicus brief of the Department of Justice which frontally attacked the doctrine. The decision was affirmed by a 4-to-4 per curiam opinion, with two silent dissenters as well. See Dunner, Gambell and Kayton, *Patent Law Perspectives*, Annual Reviews, B.1 [1][b].

which, though adding nothing, would be enough to take the copies matter outside the claim, and hence outside the reach of law. One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play, may be expected to introduce minor variations to conceal and shelter the piracy. Outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form. It would deprive him of the benefit of his invention and would foster concealment rather than disclosure of inventions, which is one of the primary purposes of the patent system."

[Emphasis added.]

Consonant with these equities, the doctrine of equivalents was "consistently applied by this Court and the lower federal courts . . ." for almost a hundred years, operating in favor of "the patentee of a secondary invention consisting of a combination of old ingredients which produce new and useful results" as well as the patentee of a pioneer invention, *supra* at 608.

Graver Tank states the methodology to be applied in adjudicating equivalents particularly in combination patents as follows, *supra* at 609:

"Equivalence, in the patent law, is not the prisoner of a formula and is not an absolute to be considered in a vacuum. *It does not require complete identity for every purpose and in every respect.* In determining equivalents, things equal to the same thing may not be equal to each other and, by the same token, *things for most purposes different may sometimes be equivalents.* Consideration must be given to the purpose for which an ingredient is used in a patent, the qualities it has when combined with the other ingredients, and the function which it is intended to perform. An important factor is whether persons reasonably skilled in the art would

have known of the interchangeability of an ingredient not contained in the patent with one that was." [Emphasis added.]

The methodology, therefore, is to address substance instead of form, and consider the element of the combination asserted to be an equivalent for the function which it performs and the qualities it imparts "when combined with" the other elements of the combination, and for its known "interchangeability" for the corresponding element of the patented combination.

Adjudicated by the *Graver* methodology, equivalence of the accused combination and the patented combination is clearly established. Both lower courts found that the accused plant was "virtually identical . . . in every other respect" with the claimed combination of the original claims 1-10, except the accused plant "utilized a turntable instead of a transfer car to transport the mobile furnaces," 523 F.2d at 502. And the lower courts found that "the turntable does perform substantially the same function as the transfer car," 523 F.2d at 503, and "achieved the same result" in the patented combination, 523 F.2d at 502. Hence, the function the turntable performs and the qualities it imparts "when combined with" the other elements of the patented combination are established.

Moreover, the "important element" that "persons reasonably skilled in the art would have known of the interchangeability," *Graver, supra* at 609, is present. The court of appeals otherwise found in determining validity that the Van Wagenen Patent No. 492,069 "shows a turntable having wheels located at its periphery which ride on a track as the turntable rotates;" and that the German Patent No. 854,207 shows "the groups of furnaces move . . . back down the tracks to a turntable where they are positioned to move onto tracks leading to the servicing area," 523 F.2d at 499. The turntable was, therefore, there ready in the pertinent art

to be substituted once the patented combination became known to respondent on inspection of petitioners' Springdale plant. It was certainly an imperceptible step to make the furnace car trackway radial rather than parallel and the transverse trackway curved in a circle rather than straight to provide for interchangeability once the patented combination was made known. By the methodology of *Graver*, equivalence and infringement are, therefore, established in substance by the lower courts' findings.

The court of appeals did not apply the *Graver* methodology in adjudicating infringement. Although purporting to follow *Graver*, the court overlooked two of *Graver's* most salient admonitions: (i) "It does not require complete identity for every purpose and in every respect", and (ii) "In determining equivalents, . . . things for [some or] most purposes different may sometimes be equivalents." Certainly, whether the transfer means selectively moves a mobile furnace from area to area by rotational motion instead of translational motion, along curved transverse tracks instead of straight tracks, or by pivoting about a central pivot instead of with another suitable drive means is of no consequence to the fundamental interrelation and operation of the patented combination⁴. It may diminish performance and quality of the patented combination because, as the lower court observed, "the turntable may be limited by the number of tracks" and "only one furnace at a time can be transferred by the turntable," 523 F.2d at 502. But it is well-settled, equivalence cannot be avoided because the accused method is less efficient and imperfectly practices the patented combination, e.g., *Ziegler v. Phillips Petroleum Co.*, 483 F.2d 858, 868, 871 (5 Cir., 1973) *cert. den.*

⁴ The court's statement that "the turntable itself is stationary and transfers the furnances by pivoting around a central point," 523 F.2d at 503, is internally inconsistent and inconsistent with its previous finding on validity that "the turntable rotates," 523 F.2d at 499.

414 U.S. 1079; and *McCullough Tool Co. v. Well Surveys*, *supra* 343 F.2d at 402.

The court of appeals' decision is also in direct conflict with the application of the doctrine of equivalents in *Tektronix, Inc. v. United States*, 445 F.2d 323 (Ct. Cl., 1970)⁵. In *Tektronix*, one of the patents was directed to an oscilloscope sweep generator circuit for establishing precise timing for the horizontal sweep. It claimed a sweep generator which included, among other things, "a pair of series connected diodes." The two infringing devices met the details and particulars of the claims fully except that substituted for the diodes in one was a pair of triodes and in the other a pair of pentodes. Although the triodes and pentodes provided some incidental benefits in the circuit, it was clear that the triodes and pentodes were used expressly and primarily for their diode function.

The Court recognized that, "Often, diodes, triodes and pentodes are not interchangeable, and thus are not equivalents, because of the different operating characteristics inherent in their construction," 445 F.2d at 329. In an earlier Court of Claims case, *Marconi Wireless Telegraph Co. v. United States*, 81 Ct. Cl. 671 (Ct. Cl., 1935), *aff'd in part and rev'd in part*, 320 U.S. 1 (1943), the court had expressly held that diodes and triodes were *not* equivalents for that invention. In that case, signal amplification, which is not possible in a diode, was a significant and material function for weak radio signals and therefore the amplifying triodes were held "not equivalent in the circuit in question." 445 F.2d at 329. In *Tektronix*, however, the court of claims cogently pointed out that it was the diode function of the triodes and pentodes that was the very reason for the use of the pentodes and triodes, "the other differences in their operating features

⁵ *Tektronix* is said to be in "facts and law denominating a classic equivalence situation," Dunner, Gambell and Kayton, *Patent Law Perspectives*, Annual Reviews B.1 [1][b].

being not so significant or material as to affect the essential operation of the circuit" 445 F.2d at 329. For the purposes of the claimed invention, therefore, the diodes and the triodes in the circuits did "operate in substantially the same way with substantially the same means to get substantially the same result." 445 F.2d at 329.

Likewise, this case is a classic case for denominating the doctrine of equivalents. Like *Tektronix*, the substantive findings of equivalence were established by the lower courts. In this case the only act which awaits is legal conclusion of equivalence by this Court in revitalizing and unfolding the methodology of its decision in *Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co.*, now twenty-five years removed.

CONCLUSION

This case presents the Court with an unprecedented opportunity of resolving *two* questions of substantial general and lasting importance to the patent laws. The first question is one of first impression for this Court, upon which a conflict in decisions among the courts of appeals has arisen. The second question involves a doctrine of tremendous importance to the application of the patent laws sorely in need of revitalizing after twenty-five years without pronouncement by this Court. The petition should be granted.

Respectfully submitted,

ARLAND T. STEIN,
THOMAS C. WETTACH
REED SMITH SHAW & McCLAY
747 Union Trust Building
Pittsburgh, Pennsylvania 15230
Attorneys for Petitioners

March 3, 1976